

1 (Jury in.)

2

3 THE COURT: All right, Mr. Robertson.

4 MR. ROBERTSON: Thank you, Your Honor. Good  
5 afternoon. This afternoon I'd like to address some of the  
6 arguments that were made by Lawson's counsel with respect to  
7 some of his non-infringement opinions, and then we'll get to  
8 the invalidity positions.

9 It's just important to remember at all times on these  
10 arguments on invalidity that it's Lawson that bears the burden  
11 of proof to you by clear and convincing evidence that these  
12 patents are invalid.

13 First, I'd like to go back to what Mr. McDonald ended  
14 with with respect to his argument that no one from Lawson ever  
15 testified that there were catalogs in this item master or that  
16 they were published by a vendor and said the only person who  
17 made that representation to you in this courtroom was Dr.  
18 Weaver.

19 Now, I think what you need do so, if that's the case,  
20 you need to put aside all the Lawson documents that talk about  
21 how you load vendor catalogs, you need to put aside those  
22 documents that showed you how they can load entire catalogs,  
23 and those were their words in their own documents, that that's  
24 what their system had the capability of doing.

25 But right before we broke for lunch, there was some

1 testimony shown of Mr. Christopherson. You will remember  
2 Mr. Christopherson was the large fellow who is the corporate  
3 representative who was here for most of trial, although he's  
4 not here today. They put up the question and answer, and the  
5 question -- this was Ms. Stoll-DeBell asking Mr.  
6 Christopherson -- using the definition the Court just gave for  
7 published by a vendor, is the customer's item master database  
8 ever published by a vendor?

9 Answer: If you looked at the entire --

10 And then the Court interposed and said, I think the  
11 answer is yes or no to start with, and then if she wants you to  
12 explain it, she can, but the jury will understand your opinion  
13 better if you preface it by giving them the guidepost from  
14 which to make the assessment if there's any further explanation  
15 she asks you for. Yes or no?

16 And the witness answered no, and that's what Mr.  
17 McDonald read to you, and that's where he stopped. But the  
18 questioning went on, and he didn't show you what he said after  
19 that.

20 The Court: Do you want to ask him to explain that?

21 Yes.

22 Question: Please explain your answer.

23 Answer: Sure. Looking at the screen that we were  
24 just talking about, item number, a vendor could not have  
25 published that because they never had access to it. That's

1 from the customer. Tracked, that's another one where the  
2 vendors would love to have the customers have everything in  
3 stock. That comes at a cost to the customer, and they don't  
4 want to do that. They may have items that are low turnover,  
5 they only use maybe once or twice a year. There's other fields  
6 that are in the item master. We talked about some of them, you  
7 know, catalog number, the vendor's part number or its number,  
8 the manufacturer number. Clearly those came from the -- the  
9 manufacturer, came from the manufacturer, and the vendor number  
10 came from the vendor, and those were in their catalogs at some  
11 point in time. The description generally --

12 And then the Court asked the question, those did come  
13 from a vendor?

14 Witness: What did come from --

15 The Court: Those that you just testified to --

16 Witness: Did come from the vendor, but --

17 The Court: So they were published by a vendor.

18 Mr. Christopherson: Those particular items, right.

19 So Mr. Christopherson did testify that the items  
20 identified by the Court in its definition of a catalog indeed  
21 did come from the vendor for the published catalogs.

22 If I could just talk now a little bit about, some of  
23 these arguments about, other arguments about published by a  
24 vendor. One of the arguments has been made that when using the  
25 Lawson system, you can only have a textual description of up to

1 30 characters. I think you heard that several times through  
2 several of the witnesses. I would urge you to look at the  
3 Court's construction when it talks about the textual  
4 description of the item. It doesn't say it has to have any  
5 limitation on the number of characters that can be used to  
6 describe the item.

7           It doesn't say, for example, that the customer, when  
8 it gets information from a vendor -- I think we heard from Mr.  
9 Yuhasz who dealt with medical equipment that when he gets a  
10 description that says syringe and they abbreviate it to s-y-r,  
11 that doesn't make it any less a description. They certainly  
12 understand what they're entering there when they put that  
13 description that they obtained from a vendor in the used  
14 abbreviations. Using abbreviations or using only 32 characters  
15 to describe the item doesn't take it outside of the Court's  
16 definition.

17           In addition, the argument that the item master is not  
18 a published catalog has no relevance to this case. The item  
19 master is not what's published. It's the information that  
20 comes from the vendor that is published and then downloaded  
21 into the item master is what's important, and that's how the  
22 Court's construction clearly reads.

23           In fact, when there was questioning about whether the  
24 item master itself was being published, repeatedly the Court  
25 sustained objections with regard to those questions.

1           Let me talk a little bit now, if I can, about the  
2     validity of these patents at issue. One of the things that was  
3     argued was that the RIMS system, for example, was in the public  
4     or on sale or the TV/2 system was in the public or on sale. I  
5     would respectfully submit to you that there was no evidence as  
6     to what the system they are describing was that was in the  
7     public domain.

8           The only thing we have with respect to the RIMS  
9     system was that which is disclosed in the '989 patent and which  
10    you will have before you and which you can look at it when you  
11    deliberate. The only thing we had with respect to the TV/2  
12    product were those two brochures; one, simply an advertising  
13    brochure, and another, this general information manual.

14          We didn't see any RIMS system demonstrated. We  
15    didn't see any TV/2 system demonstrated. We didn't see any  
16    technical documentation with respect to either of those two  
17    so-called systems.

18          Now, it was the defendant's burden of proof to show  
19    you what those functions and features of those systems were.  
20    So really, all that can be relied on here, and, indeed, I will  
21    show you shortly the only thing that Dr. Shamos relied upon in  
22    his opinions was the '989 patent, the TV/2 brochure, and the  
23    TV/2 general information system.

24          Indeed, when I asked Dr. Shamos about the RIMS  
25    system, I asked him whether or not it had two catalogs

1 disclosed. It said, okay, take us to the next element. We  
2 were discussing the claim.

3 Answer: The only claim elements missing from RIMS re  
4 at least two catalogs, a collection of catalogs, et cetera.

5 That was actually in response to Mr. McDonald's  
6 question. So Dr. Shamos acknowledges even that RIMS does not  
7 have catalogs, an element that's in 11 out of 12 claims that  
8 are at issue. You may recall that two of the inventors of this  
9 RIMS '989 patent are Mr. Johnson and Mr. Momyer, and they are  
10 also inventors on the electronic sourcing patents.

11 So you would clearly think that Mr. Momyer and Mr.  
12 Johnson are in a better position than Dr. Shamos, for example,  
13 to tell you the differences between their requisition and  
14 inventory management patent and the electronic sourcing patents  
15 at issue.

16 Certainly, as inventors on both of those patents,  
17 they are best suited to explain the differences. So what were  
18 some of the differences? Remember now, at least four people  
19 came in and told you about the differences between the RIMS  
20 patent and the patents that are at issue here. They were the  
21 three inventors who were all fully involved, and it was Mr.  
22 Hilliard.

23 You will recall that the Fisher RIMS product, its  
24 patent described there was a requisition inventory management  
25 system. Fisher wanted to be able to take over the management

1 of its customers' stockrooms and make sure that Fisher supplied  
2 their customers with Fisher product. So Fisher would fill its  
3 own inventory at a customer's location so it could fill those  
4 customers' needs quickly. You will recall that was called  
5 just-in-time or JIT inventory. That was the purpose of this  
6 RIMS system.

7 Using it, Fisher had what was known as a customer  
8 service representative. You will recall that testimony.  
9 That's a human being right there physically at the customer's  
10 location who could then look up an item, but the only way he  
11 could do that was using the item number. He didn't have  
12 keyword search capability in the RIMS system. There was no  
13 question about that.

14 Using that, that CSR could generate a requisition,  
15 but it was a requisition for Fisher product available in the  
16 local inventory. If it wasn't available in the local  
17 inventory, the RIMS system could communicate over a network  
18 back to a mainframe computer at Fisher to transmit a request to  
19 transfer the desired testimony based on its item number from  
20 one of Fisher's warehouses to the customer location.

21 Fisher was the only distributor from which the  
22 customer could obtain those products using RIMS. That was the  
23 whole purpose of the RIMS system, and that's why Fisher  
24 Scientific liked it. We want to move and push our product out  
25 to our customers.

1           In contrast, the electronic sourcing system that was  
2 a subsequent invention was intended to empower the customer  
3 himself or herself. It was to permit that customer to use the  
4 product to conduct the end-to-end procurement process. Sitting  
5 at their desktop or laptop, they could, in fact, enter  
6 keywords, search catalogs, select catalogs, select the matching  
7 items, build the requisitions themselves, generate the purchase  
8 orders, check the inventory, and do the comparison shopping  
9 features. That was the empowerment that was part of the  
10 patents, and that's exactly what the infringing Lawson system  
11 does as well.

12           Let's talk a little bit about the differences we can  
13 readily discern from the RIMS patents and the electronic  
14 sourcing patents. One way to get quickly comfortable with  
15 understanding differences is a simple exercise you can do in  
16 the jury room.

17           If we could, let's take a look at the side-by-side  
18 abstracts of the invention. Actually, could we switch this  
19 first to one of the '683 patents. If you'll look at the cover,  
20 this is the cover page of the '683 patent. On the cover page  
21 of every one of the patents that are in suit here, there is  
22 what's called an abstract.

23           You'll find there on the '989 patent, which, I  
24 believe, is both Defense Exhibit Number 10 and Plaintiff's  
25 Exhibit Number 7, you'll find it in there. There's also an



1 abstract on the '989 RIMS patent, but this abstract, this one  
2 from the '683 patent, you will find that this abstract is  
3 identical for all three of the patents-in-suit here. It's the  
4 same abstract in the '516, it's the same abstract in the '172,  
5 and it's the same abstract in the '683.

6 And so one way to understand the differences, to  
7 quickly understand the differences between the RIMS and the  
8 electronic sourcing patents is to look at this. So what are  
9 the abstracts used for at the Patent Office?

10 Their regulations say that it enables the Patent  
11 Office and the public generally to determine quickly from a  
12 quick review the nature and gist of the technical disclosure of  
13 the patent. It is a tool that the examiners use to look at the  
14 subject matter and to immediately understand what that  
15 invention is directed to.

16 So let's see how we can compare and contrast these  
17 two. I'm not going to go through all these because they are in  
18 the jury room, but there are some significant differences.  
19 First, just looking at the '989 patent, the first sentence  
20 there says, in accordance with the present invention, a  
21 requisition and inventory management system is provided.  
22 That's what it's being directed to.

23 Going down a little bit further, it says, the  
24 computers there can build and transmit to the other computer  
25 communication blocks of data relating to a particular

1 requisition of an item in just-in-time inventory. You will  
2 recall that's what Mr. Johnson and Mr. Momyer said were the  
3 Fisher products that they wanted to supply to the customer.

4           The other computer that's part of this system can  
5 then use the received data to process the requisition or to  
6 update the just-in-time inventory records. Again, we're  
7 talking about Fisher product there.

8           You'll note down here that these requisition records  
9 are created from a realtime interaction between these two  
10 computers from information -- I'm skipping down now -- entered  
11 by a customer service representative. That's the CSR operating  
12 at the local computer. That's at the customer's site.

13           So the system of the present invention, it goes on to  
14 say, utilizes means for automatically determining items in the  
15 just-in-time inventory that are likely to require  
16 replenishment. Again, that's what's talking about a Fisher  
17 product.

18           So this system then proposes a purchase and transfer  
19 order for an optimum quantity of that item, the Fisher item,  
20 which the CSR may accept or modify. So what is significant  
21 about that? Nowhere in that entire abstract is there ever even  
22 any reference to a catalog, never mind multiple catalogs.  
23 Nowhere is there any reference to a system that can be used by  
24 a customer. Instead, it refers to the CSRs operating that  
25 local computer just as the inventors testified. And the items

1 that are requisitioned from the just-in-time inventory are the  
2 Fisher products. They are not products that are able to be  
3 purchased for multiple vendors.

4 And it's important to remember, even when we're  
5 looking at the '989 patent, that the inventors testified that  
6 many of the features and functionality that are actually  
7 disclosed and described in the '989 patent were never actually  
8 even commercially utilized. For example, Mr. Momyer, one of  
9 the inventors of both the RIMS and the electronic sourcing  
10 patent, was asked the question, what you are saying is you did  
11 describe some things for a RIMS system in April of 1993 -- that  
12 was the year of the patent application for RIMS -- in the  
13 patent application that weren't actually implemented yet in the  
14 RIMS system that was on the market; is that right? That's  
15 correct.

16 So then we really don't know what the features and  
17 functionality of this RIMS system were that the defendants are  
18 relying on and they need to show you by clear and convincing  
19 evidence were present. But I'm going to show you in a minute  
20 that even if we rely on the RIMS patent itself, it doesn't  
21 provide all the functions and features of the patents-in-suit,  
22 and it's their burden to demonstrate to you by clear and  
23 convincing evidence, on an element-by-element basis for all 12  
24 claims that it's present in the prior art that they're going to  
25 rely on.

1           Take a look just a minute at the abstract of the  
2 patents that are in suit, '683, '516, and the '172 which  
3 describe to the Patent Office what the real subject matter of  
4 the invention is.

5           Here, the abstract says it's an electronic sourcing  
6 system which includes a computer that maintains a catalog  
7 database of data including product information such as product  
8 identification and descriptive information relating to catalog  
9 items available from vendor product catalogs. Right in the  
10 first sentence there, they're telling you what this is.

11           This is an electronic sourcing system. It has  
12 catalogs in it. It has product identification and descriptive  
13 information. Compare and contrast that to what the abstract is  
14 saying about the RIMS patent. It has a means for building,  
15 generating the requisition including at least one requisition  
16 item. It has a means for searching the database, for catalog  
17 items matching that information and selecting at least one  
18 catalog located as a result of that search.

19           It goes on to say it has text describing those  
20 catalog items, images of the items may be viewed. Data  
21 identifying those catalog items can be communicated to a  
22 requisition building means which generates requisition  
23 including entries for items corresponding to the selected  
24 catalog items, and significantly, the system checks the  
25 availability in one or more inventory locations for desired

1 catalog items.

2           So there it's checking multiple vendor catalog  
3 availability unlike the RIMS just-in-time inventory check.  
4 Completely different, and as you might appreciate, completely  
5 significant in the context of what we're talking about with  
6 this invention.

7           On the one hand, I'm just -- on my own have the  
8 capability to replace my Fisher product. On the other hand,  
9 the user now is empowered to select multiple catalogs, multiple  
10 items, multiple requisitions, purchase orders, and check  
11 multiple catalog inventories. So we see we have catalog items  
12 here, vendor product catalogs, and inventory from desired  
13 catalogs.

14           So even on the face of the patents themselves, it's  
15 readily apparent that these are two entirely separate  
16 inventions, and there's certainly no question that the Patent  
17 Office knew when they granted the patents that were issued here  
18 that the '989 was fully disclosed in it because it was  
19 incorporated in there, in the patents fully by reference.

20           If we could just go to the slide that is at page 65  
21 towards the back. You'll see in each of the patents-in-suit,  
22 in the background of the invention, this was read to you  
23 several times, but in the patents that are at issue here, that  
24 Lawson has accused of infringing, it tells the Patent Office  
25 right in the body of the patent about the RIMS patent. It says

1 one such system is the Fisher Scientific requisition and  
2 inventory management system, Fisher RIMS, described in this  
3 '989 patent, assigned to Fisher Scientific, and it's  
4 incorporated herein by reference.

5 And if you'll note, if we can go to the slide that is  
6 page 66, here I've tried to illustrate for you in the  
7 patents-in-suit -- these are the patents that Lawson is accused  
8 of infringing -- how many times the RIMS patent is referenced  
9 as being disclosed to the Patent Office. There are 59 separate  
10 times that the RIMS patent is described and explained as to how  
11 it was used and modified to make the inventions that are at  
12 issue here.

13 So is it even possible the patent examiner could not  
14 understand the details of the RIMS system when it's fully  
15 incorporated in by reference and it's referred to more than 59  
16 times? And, indeed, the Court is going to give you instruction  
17 on what incorporated by reference means in the jury  
18 instructions.

19 Just paraphrasing, it basically means the entirety of  
20 the '989 patent is considered to be set forth with all of its  
21 figures and descriptions and everything about it as if it were  
22 set forth just in these same patents-in-suit.

23 So clearly RIMS is not an electronic sourcing system  
24 as the Court has described. It is not a system that can be  
25 used by a prospective buyer to locate and find goods to

1 purchase from different sources, suppliers, or distributors,  
2 and that's what the Court has defined an electronic sourcing  
3 system to mean. The RIMS system was not even used by a buyer,  
4 rather as -- the evidence demonstrates it was used by that CSR  
5 of the distributor, Fisher Scientific.

6 RIMS couldn't be used to locate goods to purchase  
7 from multiple different suppliers or vendors. The only  
8 distributor from which those goods were procured were through  
9 Fisher Scientific. There were no multiple catalogs. As I  
10 think I indicated, even Dr. Shamos agrees that the RIMS system  
11 didn't have multiple catalogs.

12 The item records in RIMS were for a local database,  
13 and they didn't have vendor source-related information since  
14 all the products were obtained from Fisher Scientific. You  
15 couldn't select product catalogs in RIMS since they didn't have  
16 them. You couldn't search for matching items among selected  
17 product catalogs because there were no product catalogs to  
18 select.

19 The only thing you could do in the RIMS system was  
20 retrieve an item record from the RIMS part master database by  
21 performing an item number lookup. All the inventors testified  
22 to that, and Mr. Hilliard testified to that. And the problem  
23 was if you didn't know the item number, you couldn't retrieve  
24 the item from the -- the record from the database because that  
25 was the only way to look it up. There was no search

1 capability, no keyword search.

2           Given the fact that you didn't have matching items,  
3 you couldn't build requisitions with those matching items from  
4 the catalogs, you couldn't generate purchase orders from those  
5 requisitions for those catalogs, and you couldn't check  
6 inventory of the multiple vendors.

7           The cross-reference tables that are discussed in the  
8 '989 patent were simply to cross-reference a competitor's part  
9 number with a Fisher part number so if the customer asked for  
10 the competitor part number, Fisher could say, you know what, we  
11 have the same product. Corning, for example, I think was one  
12 of the examples in the case, might be offering a 50-milliliter  
13 beaker that had a specific part number that Fisher was able to  
14 learn about, and it created a cross-reference table to say,  
15 that corresponds to our 50-milliliter beaker, so if the  
16 customer wants this, we can try and sell them our Fisher  
17 product.

18           It had nothing to do with the cross-referencing or  
19 comparison shopping that is at issue in these patents. Again,  
20 RIMS could not determine the availability of a selected  
21 matching item from a catalog in inventory. It could only track  
22 the inventory of the Fisher products.

23           So, let's talk about now this combination that's  
24 being alleged that RIMS and TV/2 could be put together in some  
25 fashion to come up with the patents-in-suit. Again, let me



1 just suggest to you that the Patent Office was fully aware of  
2 the RIMS -- excuse me, the TV/2 product. If you could just  
3 show, I think it's page 67. Here's TV/2 disclosed in the  
4 patents-in-suit. I've highlighted it in green. 32 times the  
5 inventors told the Patent Office about features and  
6 functionality of TV/2 in the same patent and what aspects  
7 needed to be modified, what aspects could be included and how  
8 we could invent the new useful and nonobvious invention that is  
9 the subject of these patents.

10 If you put them together, there's something like 91  
11 separate references. Certainly the Patent Office understood  
12 that these two references, and they were fully aware of them --  
13 if we can cite the face of the patents in which the two  
14 brochures are disclosed. You see there that Fisher Scientific  
15 actually gave the Patent Office the Technical Viewer/2 general  
16 information manual, and this IBM Technical Viewer/2 product  
17 information brochure.

18 Now the argument has been made that these were in the  
19 public domain. That may have been the case, that may not have  
20 been the case as of August of 1993. There's been no  
21 corroboration that they were, in fact, out in the public.  
22 There's been some testimony based on memories that are some 17  
23 or 18 years ago. You might remember Mr. Gounaris says he  
24 recalls being at a meeting some 17 years ago where he actually  
25 handed someone a brochure or saw someone hand a brochure to a

1 Fisher Scientific person.

2 I would just ask you to consider the credibility of  
3 that statement; first that he remembers actually being at a  
4 meeting then 17 years ago and then he has a specific memory  
5 that he either handed it or he saw somebody hand it. You would  
6 think if he has a specific memory, he would know whether it was  
7 him or somebody else, but is it credible to suggest that  
8 someone remembers being at a meeting 17 years ago and handed  
9 out a specific document, or was that self-serving testimony  
10 from a paid witness by Lawson who wants to have that suggestion  
11 become part of the record?

12 So let's take a look and see if we can identify  
13 really what it is Lawson alleges is the prior art. If we can  
14 go to slide 61, please.

15 First we have this '989 patent, as I say, invented by  
16 Mr. Johnson and Mr. Momyer and disclosed to the Patent Office,  
17 and then we have this TV/2 general information brochure, and we  
18 have this TV/2 advertising brochure, all of which the Patent  
19 Office has. There's no question about that.

20 Then there's this Fisher RIMS system which we're  
21 really not clear what that is; the RIMS brochure, well, that is  
22 going to be in evidence, but you'll see that that's simply an  
23 advertising brochure, and there's no argument that's made that  
24 the advertising brochure anticipates any of the claims at issue  
25 in this case. Then there's this unspecified TV/2 system which

1 we really don't know what the details of that are. All we have  
2 to look at are those two brochures.

3 Now, you will recall testimony that the RIMS system  
4 went through many variations and iterations. For example, Mr.  
5 Momyer was asked, let me just stop you there and say,  
6 approximately how many iterations or variations did the system  
7 go through?

8 Dozens, if not more than that. The Fisher RIMS  
9 system was in existence from 1991 all the way through until I  
10 left in 2003, and there were many iterations of that.

11 Unlike Lawson, Dr. Shamos testified that he didn't  
12 rely upon any unspecified RIMS system or unspecified TV/2  
13 system. I asked Dr. Shamos, and you are aware that the RIMS  
14 system, starting, perhaps, in the late '80s all the way up  
15 through until the year 2000 went through many iterations;  
16 correct, many different versions?

17 Answer: Yes.

18 Which version are you relying on when you are  
19 rendering your opinions?

20 That described in the '989 patent.

21 So with respect to the evidence you presented,  
22 though, did you present anything outside of the '989 patent to  
23 support your opinions?

24 Answer: Not in this courtroom.

25 I then asked him, did you point to any other version

1 or produce any documentation of the technical nature of the  
2 RIMS system as being used between 1989 and 2000?

3 No, I didn't personally because, as I said, I don't  
4 have personal knowledge of the RIMS system as distributed.

5 Well, let me suggest, if Lawson's paid expert didn't  
6 have any knowledge of the RIMS system as distributed, how could  
7 they possibly rely on some unspecified RIMS system, and how  
8 could they possibly ask you to determine what it was if they  
9 have no evidence to show, and that, again, was their burden to  
10 come forward. They could have made inquiries, they could have  
11 subpoenaed Fisher Scientific, they could have tried to gather  
12 additional evidence, but they didn't offer it here before you,  
13 and Dr. Shamos doesn't even understand what the features and  
14 functionality of this unspecified RIMS system was.

15 I also asked Dr. Shamos about the TV/2 system.

16 Question: So it's fair to say you don't rely on some  
17 actual operating TV/2 system in your report because you never  
18 saw it; right? You just have two documents that you are  
19 relying on, isn't that right?

20 Yes.

21 Asked about those TV/2 brochures, you have no  
22 personal knowledge, do you, that either of these documents were  
23 ever in the public domain prior to August of 1992, do you?

24 I have no direct personal knowledge of that.

25 So, were they publicly disclosed? I don't know.

1 Perhaps, but is that clear and convincing evidence for you to  
2 say that these things were in the public domain when nobody has  
3 come forward and proved concretely that's the case? There's  
4 been no corroboration.

5 Ms. Eng testified she thought so, and I actually  
6 found her to be a fairly credible witness notwithstanding that  
7 she was a Lawson consultant paid by Lawson to testify here.  
8 But she was doing all this from memory, and it's memory of  
9 events that are 18 years ago without any corroboration, and  
10 you'll see that the judge will instruct you as to what is  
11 necessary in order to corroborate whether or not something is  
12 actually out in the public.

13 So what are we left with if we can put to the side  
14 these unspecified systems of which we have no details? We're  
15 left with the '989 patent and the two brochures, all of which,  
16 again, there's no question the Patent Office had before them.

17 So when you consider that Lawson is claiming that  
18 they have to prove by clear and convincing evidence, you have  
19 to evaluate, among the other factors, each difference between  
20 every element of each one of the 12 claimed patents and this  
21 alleged combination of prior art.

22 Let's discuss the TV/2 brochures first. Neither  
23 brochure provides technical details of how to build a TV/2  
24 search program such that a person of ordinary skill in the art  
25 would make and use that program. Mr. McDonald said, and I

1 wrote it down when he was making the argument, he said anyone  
2 of ordinary skill would understand how to combine these things.  
3 I would respectfully suggest to you that Ms. Eng, who was at  
4 IBM and who had a computer science background and had years of  
5 programming experience, she's probably the kind of person of  
6 ordinary skill in the art that we're talking about here, and  
7 notwithstanding that she was a paid Lawson witness, you would  
8 think if anybody could have combined them like Mr. McDonald has  
9 suggested, wouldn't it be her?

10 Question was asked, you'd agree that this general  
11 information manual does not provide enough information for  
12 anybody as to how to integrate a TV/2 search engine with  
13 electronic catalogs; correct?

14 It does not. It's just general information.  
15 Remember the that general information manual is the more  
16 detailed of the two brochures. The other one is a just an  
17 advertising puff piece. If the information manual can't help  
18 us, how possibly can that advertising brochure?

19 And there was also no evidence to substantiate that  
20 IBM ever had a commercial version of the TV/2 search program  
21 prior to IBM's work on the electronic sourcing system. Ms. Eng  
22 acknowledged that as well. Lawson wants to rely on a single  
23 bullet point from that marketing brochure as providing some  
24 sort of suggestion to combining the two.

25 However, that single bullet point talks about

1 possibilities and doesn't give you any details, technical or  
2 otherwise, on how you might combine these systems. It doesn't  
3 even tell you how to use the search results to build a parts  
4 list which could be sent to a parts ordering system. Mr.  
5 Hilliard indeed says even if you combine the two systems on an  
6 element-by-element basis, the combination would not satisfy all  
7 the requirements of any claim.

8           It's because you are combining a system that can  
9 simply check the existing inventory of Fisher product, not  
10 multiple vendor products, with a search program that can simply  
11 read documents. That doesn't give you the elements of the  
12 electronic sourcing system that requires multiple catalogs.

13           Neither system, it was conceded, was not an  
14 electronic sourcing system. Neither system can generate  
15 requisitions having line items associated with multiple  
16 sources, and neither system can generate purchase orders,  
17 multiple purchase orders from a requisition.

18           As we heard from the inventors and the IBM employees,  
19 significant modifications needed to be made to both the RIMS  
20 and TV/2 system to render them useful for the electronic  
21 sourcing system patents.

22           By now, I've know you've seen repeatedly that  
23 statement of work between IBM where Fisher contracted them and  
24 paid them more than \$600,000 to work with them in a year and a  
25 half to make all those modifications. I asked Ms. Eng about

1 all the modifications that needed to be made to the TV/2  
2 product in order for it to be adapted to the electronic  
3 sourcing product, and she testified at length. You may recall  
4 the inventors were asked what they needed to do. One of the  
5 things that was important was that an interface for the RIMS  
6 system had to be created.

7 Mr. Johnson said, did you have that interface in RIMS  
8 system, or did it have to be created?

9 No, that was not in the RIMS system. That had to be  
10 created.

11 In addition, he was asked other questions concerning  
12 the project in order to result in the inventions at issue here.  
13 In modifying this requisition coding, did it also address any  
14 issues involving the purchase orders from these requisitions?

15 Answer: Yes. The system would then create that,  
16 would then take that requisition and, by vendor, create  
17 multiple purchase orders with the products associated to that  
18 vendor.

19 In addition, there needed to be modifications for  
20 connections to outside vendor databases, because that was never  
21 in the RIMS system, in order to determine the availability of  
22 selected items, inventors' inventory. You needed to add a new  
23 cross-reference table that would enable you to convert a  
24 selected matching requisition of one vendor to a comparable  
25 item to a different vendor, none of which was present in the



1 RIMS system.

2 So the question, you also, I think, mentioned that  
3 you had to modify requisition coding; is that correct?

4 Answer: The RIMS system could only communication to  
5 the Fisher mainframe, Fisher being Fisher Scientific. We  
6 changed those programs to add multiple products from different  
7 vendors to a single requisition.

8 So Ms. Eng, Mr. Kinross, Mr. Momyer described those  
9 numerous modifications that were made to the TV/2 viewer  
10 document, viewer search program including there was tagging  
11 catalog data so the search program could be made to look in the  
12 proper places to find the relevant information about catalog  
13 items.

14 And building order list capability, building an index  
15 to facilitate searches of large items of data, all of these,  
16 you will see when you retire to the jury room, are outlined in  
17 that Gantt chart that took more than a year and a half to  
18 complete those tasks.

19 Mr. Momyer testified, did you understand, was there  
20 any limitation on the TV/2 system ability to communicate with  
21 the RIMS system regarding multiple catalogs from multiple  
22 vendors?

23 Answer: Well, my understanding, I didn't think the  
24 TV/2 system, as it was presented to us, could handle multiple  
25 catalogs and could not search multiple catalogs. That was my

1 understanding. That's the reason we did the development that  
2 we did.

3 Now, Dr. Shamos wants to suggest these modifications  
4 were trivial tasks easily accomplished with no information  
5 other than that which would be found in those two brochures,  
6 but the actual facts from the inventors' testimony, Ms. Eng's  
7 testimony, and the IBM documentation all speak otherwise.

8 So let's talk a little bit about some of the  
9 witnesses that came here, if we can, that Lawson presented.  
10 First, there was Ms. O'Loughlin. You may recall that she was  
11 the in-house counsel at Fisher Scientific, and they played her  
12 videotape. She was the one who was responsible for filing a  
13 trademark application, that Fisher advertising brochure on the  
14 RIMS product. It was suggested that there was a lot of arguing  
15 over the date of that brochure.

16 When that brochure came up, I stipulated that it was  
17 attached to that April 1993 trademark application and that it  
18 at least had to be in the public domain as of that date. I  
19 didn't quibble with that, but the fact is, if you look at that  
20 brochure, it doesn't tell you what RIMS system was there. In  
21 fact, the inventors said many of the things that were in that  
22 advertising piece actually never were part of the RIMS system.

23 And now, there's not a single anticipation argument  
24 made with respect to that, but what did Ms. O'Loughlin, a  
25 lawyer, not an engineer, candidly admit about the features and

1 functionality of the RIMS system? Question was asked, how many  
2 iterations did the Fisher RIMS system go through?

3 I don't know.

4 Do you know how the features and functionality  
5 changed during the period of time from 1992 to 1995, for  
6 example?

7 I do not.

8 You were asked about this entry italicized computer  
9 order entry system. Do you see that?

10 I do. That was in the, one of the brochures.

11 Can you tell me where in this paragraph it discusses  
12 the capabilities of searching multiple vendor catalogs?

13 I don't see it there.

14 She was also asked about the annual reports that Mr.  
15 McDonald referenced. I asked her, does it discuss in there any  
16 other catalog other than the Fisher catalog, and you'll see  
17 when you look at those annual reports, that the only catalog  
18 that's ever discussed is the Fisher catalog consistent with, in  
19 fact, the testimony of the inventors and the disclosure in the  
20 '989 patent itself.

21 Lawson also called Richard Lawson in, the founder of  
22 the company, very nice man. He talked about the early years of  
23 Lawson. He lives in Dallas. His company operates out of St.  
24 Paul, Minnesota. He testified he hasn't been involved in the  
25 products that are issue here for over the last five or six

1 years. He didn't really -- I didn't really understand that he  
2 had much relevance to contribute, but Lawson is entitled to  
3 call whoever they wanted to call, but he candidly admitted that  
4 since 2003, when the products at issue were at issue here, he  
5 has not been involved in any of the development of the products  
6 at issue in this case.

7 Question: So it's fair to say you haven't been  
8 involved in the day-to-day operations of the company for quite  
9 some time; is that right?

10 Since it went public. I have been retired for five  
11 years.

12 So with respect to those products, did you have some  
13 role in developing those products?

14 Well, since 2003, the answer is, since I left, the  
15 answer, that would be basically no.

16 Pamela Eng was asked a question about what she  
17 disclosed with respect to TV/2, in particular the application  
18 programming interface. Slide 56, please, Mike. Did you ever  
19 give the TV/2 API to anybody else besides Fisher?

20 Not that I know of, no.

21 And the API is necessary for this project; right?

22 If you want to integrate it with another system.

23 Lawson also called Mr. Charles Gounaris. You will  
24 remember Mr. Gounaris was the gentleman who testified that he's  
25 made tens of thousands of dollars as a professional witness in

1 these ePlus cases testifying on behalf of infringers.  
2 Surprisingly, Mr. Gounaris didn't really contribute much of  
3 anything. Ms. Eng, when asked about Mr. Gounaris, said, he was  
4 a fellow in sales, wasn't he? He didn't work in Manassas where  
5 the project was going on.

6 I don't think he contributed much of anything or  
7 certainly didn't contradict anything that Ms. Eng had to say.

8 So let me say in closing, I do want to come back, and  
9 you've been importuned a number of times on this issue about  
10 using common sense, which, of course, we all need to do. This  
11 case has certainly been challenging and complex on the  
12 technology. I confess candidly I don't fully understand all  
13 the aspects of these inventions. I was not a computer  
14 scientist in college, but I can tell you one thing that's not  
15 another or two things aren't the same, and I have every  
16 confidence that you can do so yourselves.

17 So I just would like to put out some questions, if I  
18 could, that you should think about or ask you respectfully to  
19 think about during your deliberations. Why, for example, would  
20 Fisher Scientific go out and commit the kind of resources it  
21 did, its people, its money, its time, to build a new system,  
22 this electronic sourcing system, if it already had that  
23 invention in RIMS? Why would they commit four of their  
24 employees, Mr. Melly, Mr. Momyer, Mr. Johnson, Mr. Kinross, the  
25 latter two full time, to a two-year project in research and

1 development if they already had the invention right in their  
2 backyard?

3 Why would they go out and contract with IBM and pay  
4 them \$600,000 and spend that year and a half in order to build  
5 an electronic sourcing system incorporating a completely  
6 revamped TV/2 program, itself which had to go through  
7 substantial revisions and modifications, in order to come up  
8 with an invention they already had?

9 Why would Fisher hire several patent attorneys and  
10 pay them to prepare patent applications with the Patent Office  
11 for an invention they had already patented? Why would Fisher  
12 Scientific pursue those patents for nine years paying the  
13 Patent Office application fee after application fee after  
14 application fee and continue to pay the patent attorneys for  
15 that nine-year period to obtain an invention they already had?

16 Why would the inventors spend two years of their  
17 lives trying to develop an invention they already invented?  
18 Who would do that? You saw those inventors. They were proud  
19 of their invention. They truly believe they had invented  
20 something new and novel, nonobvious, and not the RIMS system.

21 You might remember, I asked Dr. Shamos why someone  
22 would go all through this and pay IBM that money, and his  
23 cynical response was, it was just because IBM wanted to make  
24 the money. Do you think that's really why Fisher did this or  
25 IBM?

1           Would the inventors have had the pride they had in  
2           their invention if they had only reinvented the same wheel? I  
3           don't think so. So don't take their inventions away from them,  
4           and don't take ePlus's patents away from them on the basis of  
5           this infringer's arguments.

6           Lawson is simply looking to escape the consequences  
7           of its own actions, and to do that they ask for your help.  
8           That is why they ask you to invalidate a patent that's presumed  
9           valid, and the thin evidence they've presented here falls far  
10          short of their significant burden.

11          I'm not going to walk you through that verdict form  
12          that Mr. McDonald mentioned. I think it is going to be  
13          relatively clear on its face, but we would respectfully ask  
14          that when it comes to the five configurations at issue in the  
15          specific claims that are involved, that ePlus has demonstrated  
16          by a preponderance of the evidence that Lawson's system  
17          infringes those claims, and we'd ask you to check yes.

18          With respect to the invalidity allegations, you're  
19          going to be asked a number of questions with respect to whether  
20          claims are anticipated or rendered obvious. I would  
21          respectfully ask, and I believe that the evidence shows, that  
22          Lawson hasn't met its burden by clear and convincing evidence  
23          that any of these patent claims are invalid as either being  
24          anticipated or obvious, so I respectfully ask that each of  
25          these boxes should be checked no.

1           You are also going to be asked if you do find that a  
2 claim is invalidated to specify the prior art that would be  
3 relied on. If you do not find it invalid, you need not include  
4 any prior art reference alleged by Lawson to invalidate those  
5 claims.

6           So I thank you for your time, and we thank you for  
7 your public service.

8           THE COURT: May I see counsel for a moment.

9  
10          (Discussion at sidebar as follows:)

11  
12          THE COURT: You say, and then you have to fill in the  
13 blank in section C, which is obviousness, which prior art are  
14 you relying on. There you should put in, just put in RIMS plus  
15 TV/2 system.

16          Now, as I see it, that changes significantly your  
17 whole theory of what it is that is prior art that constitutes  
18 obviousness, because you are telling them what they need to do  
19 is put in RIMS system plus TV/2 system. Did I --

20          MR. McDONALD: I think I might have said it that way.  
21 I meant to say at least instead. At least put in those two,  
22 but I did not read that into those two things. I misspoke.

23          THE COURT: They can't do that under the evidence.  
24 In the first place, your expert didn't even rely on those. He  
25 relied on other things, so I'm not even sure it's proper for



1 any of it to go to the jury anyway, but I think they'll figure  
2 it out, but if you don't include the '989 patent in the  
3 obviousness, you're dead. So you say you made an error.

4 MR. McDONALD: That's right.

5 THE COURT: All right. I think what they have to do  
6 is to say if they have one, they have to specify it's the '989  
7 plus TV/2 brochure, '989 plus TV/2 whatever. I mean whatever  
8 the combo is, they have to say exactly what they find and only  
9 what they find.

10 MR. ROBERTSON: Your Honor, I think the verdict form  
11 is going to be clear on its face.

12 THE COURT: It is. I think it is, but his statement  
13 was at odds with the verdict form. I just want to make sure  
14 I'm not giving the jury contradictory messages, and I didn't  
15 feel free to tell them you were wrong without consulting you.

16 MR. McDONALD: Is that something you are going to  
17 correct, or do you want me to?

18 THE COURT: I'm going to have to correct it.

19 MR. ROBERTSON: I would not want undue emphasize  
20 placed on the verdict forms, and the instructions spell out  
21 what alleged prior art they can consider.

22 THE COURT: If I do it wrong, object, and you can  
23 object if you want to if I don't do it right, I foul it up, but  
24 the jury is entitled to know what they really have to do.

25 MR. ROBERTSON: I'd be loath to object to the Court's

1 instruction at this critical juncture.

2 THE COURT: You can object to it, and if you want to,  
3 you can come up here and do it quietly. There's nothing wrong  
4 with objecting to what Courts do. That's what the lawyers get  
5 paid for. You just have to be right so you can prevail.

6 MR. ROBERTSON: That's right.

7

8 (End of sidebar discussion.)

9

10 THE COURT: My instructions are going to take about  
11 45 minutes or an hour. What I think we'll do is probably go to  
12 a logical breaking point and give you a little break in  
13 between. Does anybody need a break now before we start? Okay.

14 These instructions are something that you're going to  
15 have back in the jury room with you, and you can read them.  
16 Nonetheless, I think it's helpful for us to have time together  
17 for me to present them to you, and that's why -- and over the  
18 years, it's been shown that that is helpful, and that's why I  
19 will be doing some reading to you.

20 In most cases, I know all the instructions pretty  
21 well by heart, having done this for a long time, but as you  
22 have learned, the patent law issues are very technical, and so  
23 I need to be accurate, and I'll be probably reading a little  
24 bit more than I usually do.

25 If you find that my reading tends to put you to

1 sleep, you let me know and we'll stand up and take a stretch  
2 break, because I do know that, in fact, that is a phenomenon  
3 that can happen, and I charge you, if you are drifting off, let  
4 me know. That's the time for us to take a break, and we'll go  
5 from there.

6 I promise you I won't be the least bit offended,  
7 because I know you have the toughest, most important job of  
8 anybody in this courtroom. These lawyers have worked very  
9 hard, and they've done a great job trying to make the case for  
10 their respective clients and put together a case that you could  
11 understand out of some very difficult issues, and now you have  
12 to -- now you have to do your duty.

13 And now that you've heard the evidence and the  
14 arguments, it's my duty to give you the instructions on the law  
15 that you are to follow in the case, and it's your duty as the  
16 jurors to follow the law as it's stated here and then apply the  
17 law to the facts in the case.

18 The lawyers properly have referred to some of the law  
19 in their arguments, and it's okay for them to do that, but if  
20 there's any difference between what you heard them say and what  
21 you hear the Court say, obviously you're to be guided by what  
22 the Court's instructions say, not that I suggest that they  
23 misstated anything, and if they did, I don't believe that  
24 either one would have done it deliberately, but sometimes when  
25 you are talking and you are doing what they were doing, you say

1 things that aren't exactly right and without meaning to. So if  
2 there's any contradiction, you follow what the Court says.

3 You are not to single out any one instruction as  
4 stating the law, because they are all intended to work together  
5 to help you do your job. Nor are you to be concerned with the  
6 wisdom of the rules of law, because it would be a violation of  
7 your sworn duty and your oath to apply any view of the law  
8 other than the law as you are given here, just as it would be a  
9 violation of your duty to decide the case on anything other  
10 than the facts that are produced here.

11 Because you are the judges of the facts and you keep  
12 in mind that justice through trial by jury always depends on  
13 the willingness of each juror individually to seek the truth  
14 from the facts and the facts from the same evidence that's been  
15 presented to you all and to give -- and to apply the same law.

16 You are to perform this duty without bias or  
17 prejudice to either party, because the law doesn't permit  
18 juries to be governed by sympathy or prejudice or public  
19 opinion. Indeed, the parties and the public expect that you'll  
20 carefully and impartially consider all the evidence in the  
21 case, follow the law as stated by the Court, and reach a just  
22 verdict regardless of the consequences.

23 The case is between two corporations, and you should  
24 realize that the case is to be decided by you as persons of  
25 equal standing in the community, of equal worth and holding the

1 same or similar stations in life. And the corporations are  
2 entitled to the same fair trial at your hands as would a  
3 private individual be. They stand equal before the law and are  
4 to be dealt with as equals in a court of justice.

5 Now, there's nothing particularly different in the  
6 way that a jury should consider the evidence in a trial from  
7 that in which any reasonable and careful person would treat any  
8 very important question that has to be decided by facts and  
9 listening to facts and evidence and opinion, and, therefore,  
10 you are expected to use your good common sense.

11 The lawyers both said it, and I will reiterate it.  
12 In considering and evaluating the evidence for the purposes for  
13 which it's been admitted and to give the evidence -- you're  
14 permitted to give the evidence a reasonable and a fair  
15 construction in light of your common knowledge of the natural  
16 inclinations and tendencies of human beings.

17 I told you earlier and I remind you now, it's the  
18 sworn obligation of the lawyer to object if the lawyer feels  
19 like the other side is offering evidence that's not in keeping  
20 with rulings of the Court, rulings of evidentiary principles,  
21 or rules of procedure, and that's how they get a ruling in our  
22 system. So don't be upset with a lawyer or his or her client  
23 because an objection was made by him or her, and don't be  
24 influenced because one side lost the objection and the other  
25 side prevailed, because I'm just applying the Rules of Evidence

1 and the rules of procedure to objections that have been made  
2 and not taking sides in the case, and it's the duty of the  
3 Court to admonish an attorney who, out of zeal for his or her  
4 cause, does something that the Court feels is not in keeping  
5 with the Rules of Evidence or rules of procedure.

6           You, of course, are to draw absolutely no inference  
7 against the side, that is the client, to whom an admonition of  
8 the Court for a lawyer may have been addressed during the trial  
9 of the case.

10           I've asked some questions in the case. Don't assume  
11 that I hold an opinion on the matters to which my questions  
12 related. The Court can simply ask questions to clarify a  
13 matter, not to help one side or hurt the other.

14           Remember that the evidence consists of the sworn  
15 testimony of the witnesses regardless of who called them, the  
16 documents that have been admitted into evidence regardless of  
17 who offered them into evidence, and all of the facts that have  
18 been stipulated, and there's a written stipulation in the case,  
19 and you'll have that, and those facts which have been  
20 stipulated means the lawyers and the clients on both sides have  
21 agreed, and you are obligated, unless something -- I tell you  
22 otherwise to accept the stipulation as evidence and regard the  
23 stipulated facts as proved.

24           Remember what I told you at the beginning, that the  
25 opening statements, the closing arguments, the questions, and

1 objections of counsel, the questions of the Court, are not  
2 evidence in the case. Any evidence as to which an objection  
3 was sustained and which I told you to disregard is not evidence  
4 in the case, and we expect that you'll disregard that in making  
5 your deliberations.

6 Remember that anything you've seen or heard outside  
7 the courtroom isn't evidence, and you are to disregard it. So  
8 you are to consider, therefore, only the evidence in the case,  
9 but when you are doing that, you're not limited to just the  
10 bald statements of the witness or what appears in the  
11 documents, because you are permitted to draw from the facts  
12 which you find have been proved any reasonable inferences as  
13 you feel are justified in the light of experience, and an  
14 inference is just a logical deduction or conclusion that reason  
15 and common sense lead you to draw from the evidence that's been  
16 received.

17 Remember there are two types of evidence in the case  
18 that I told you about earlier. There's direct evidence and  
19 circumstantial evidence. I explained that earlier, and I tell  
20 you now the law doesn't make any distinction between direct  
21 evidence and circumstantial evidence. You are to consider it  
22 all. Nor does circumstantial evidence have to be of any better  
23 quality than direct evidence. You consider every bit of it.

24 One doesn't require more certainty than the others,  
25 because you can consider both direct and circumstantial

1 evidence. Now, corporations here are involved as parties in  
2 the case, and, of course, corporations can act only through  
3 natural people such as you and me as the agents or employees,  
4 and in general any agent or employee of a corporation may bind  
5 the corporation by his acts and declarations made while acting  
6 within the scope of the authority delegated to the employee or  
7 the agent and within the scope of those duties.

8 Now, the lawyers have made references to facts in  
9 their arguments, and I have, on occasion, made references to  
10 some of the testimony and facts in ruling on things here, on  
11 objections that is. If any reference to a fact that is made by  
12 the Court or by the lawyers doesn't coincide with your own  
13 recollection, remember, it is your recollection that controls,  
14 not what they say and not what I say, because you are the  
15 judges of the facts.

16 I told you earlier, too, that you are going to be  
17 judging the credibility of witnesses. That just means who do  
18 you believe and how much of what they have to say do you  
19 believe. You bring to that skill the talent that you exercise  
20 in everyday life. There isn't a day that goes by that somebody  
21 doesn't tell you something that you have to decide whether you  
22 are going to believe or not.

23 Well, you probably do everything I'm going to mention  
24 now, but if you don't, keep in mind that this is what you need  
25 to do when you are assessing the credibility of the witness:



1           Scrutinize the testimony that's given. Consider the  
2     circumstances under which each witness has testified. Consider  
3     every matter in evidence which tends to show whether a witness  
4     is worthy of belief or not. Consider each witness's  
5     intelligence, motive, and state of mind and demeanor, the way  
6     they act, and manner while on the stand. Somebody tells you  
7     something, you look at them, you listen to them, and you judge  
8     by the way they act in part whether what they are saying is  
9     right or not.

10           You can do that here, too. Consider what the  
11    witness's ability was to have observed the matters as to which  
12    he or she has testified and whether the witness impresses you  
13    as having an accurate recollection of the matters. Consider  
14    also any relation each witness may bear to either side of the  
15    case. Consider the manner in which the witness might be  
16    affected by the verdict and the extent to which, if at all,  
17    each witness is either supported or contradicted by other  
18    evidence in the case, because you are to consider all the  
19    evidence.

20           Remember that inconsistencies or discrepancies in the  
21    testimony of a witness or between the testimony of different  
22    witnesses may or may not cause you, the jury, to discredit such  
23    testimony, but remember this: When two or more people witness  
24    an incident or transaction, they just simply may see it or hear  
25    it differently, and innocent mis-recollection, like failure of

1 recollection, isn't an uncommon experience. And so in weighing  
2 the effect of some discrepancy, always consider, does that  
3 discrepancy pertain to a matter of importance or to some  
4 unimportant detail? And does that discrepancy result from  
5 innocent error or from deliberate falsehood?

6 After making your own judgment, you're going to give  
7 the testimony of each witness such credibility, if any, as you  
8 may think it deserves. That is up to you to do.

9 Something came up during the trial that I need to  
10 sort out for you. Several days ago, Mr. Christopherson  
11 testified, and there was some testimony about whether Lawson  
12 obtained an opinion of counsel of non-infringement or  
13 invalidity on the patents. I instruct you now that I have  
14 excluded that testimony. That issue is simply not pertinent to  
15 the case. It has nothing to do with the case, and I'm  
16 instructing you to disregard whatever was said about the  
17 intention or nonintention of counsel by Lawson.

18 Now, several times during the trial, the lawyers have  
19 pulled out depositions and have asked a witness a question and  
20 said, on such and such a date, didn't you say this after the  
21 witness has said something here in court.

22 A deposition is a sworn statement made out of court  
23 but under oath, but the testimony of a witness can be  
24 discredited or impeached by showing that a witness made  
25 statements earlier which are different or are inconsistent with

1 what the witness testified to in court.

2           So if I come to court and I testify that a traffic  
3 light was red, and that's my testimony, but at some earlier  
4 time I've been deposed or I've written down something, and I  
5 said the light was green, you can consider what I said before  
6 in evaluating what I said here in deciding which is it that you  
7 should accept. There'll be lots of reasons why maybe people  
8 give inconsistent statements, and you'll just have to sort that  
9 out.

10           Now, this earlier inconsistent or contradictory  
11 statement of a witness who is not a party -- that would be Ms.  
12 Eng -- who are the nonparties who testified? Actually Ms. Eng  
13 is a consultant, isn't she?

14           Mr. Yuhasz, let's say that that was Mr. Yuhasz who  
15 said the green light, red light, all right? Well, in his case,  
16 the only reason you can consider that outside testimony is to  
17 decide whether to believe what he said in here, that is you  
18 say, well, he said something inconsistent, so I'm not sure I  
19 want to believe him, or it was inconsistent, but it's not a big  
20 deal, so I'm going to go ahead and accept what he said in court  
21 even though he did say something inconsistent. In other words,  
22 you can use it to evaluate his credibility.

23           It's your responsibility to do that. Now, where a  
24 party in the case, by -- and that's a corporation by its  
25 witnesses, admits some fact or facts, then if that's knowingly

1 done, that can be considered as well -- that is in the previous  
2 statement, as evidence of the truth of the fact as well as for  
3 judging the credibility.

4           So if Mr. Christopherson said green when, in fact, he  
5 testified to red here in court, you can consider the fact he  
6 said it was green for two purposes: One, whether it was green  
7 or not; two, whether it was right when he said it was here --  
8 when he said what he said here which is red, that is to  
9 consider his credibility.

10           Now, there have been certain demonstratives. In  
11 fact, there have been a lot of demonstrative exhibits shown to  
12 you in the course of the trial. Those are sometimes referred  
13 to as demonstrative exhibits, and they are used for convenience  
14 and to help explain the facts of the case to you, but they are  
15 not themselves evidence or proof of any facts, and, therefore,  
16 when you go back to the jury room, you're not going to have the  
17 demonstratives. You're going to have the actual exhibits from  
18 which the demonstratives were made.

19           We're going to deal with expert opinions. Expert  
20 opinions -- usually the rules of evidence don't let people give  
21 opinions in cases, but in the case of someone who is an expert,  
22 that rule changes and the expert can give opinion, and Dr.  
23 Weaver and Dr. Shamos -- is it -- Dr. Shamos, yes, both of  
24 them. Mr. Hilliard, all were experts, and they gave opinions.  
25 And they are entitled to do that.

1           An expert is someone who, by education or experience,  
2   may have become knowledgeable in some technical or scientific  
3   or specialized area, and if that knowledge can help you in  
4   understanding some of the evidence or in determining a fact,  
5   then that witness can state his opinion, but remember, what  
6   they said are their opinions. That was their view of things.  
7   They didn't always say, well, it's my opinion that, but as a  
8   basic proposition, everything that they testified to was  
9   opinion.

10           And you can consider opinions received into evidence,  
11   and you can give the opinions such weight as you think it  
12   deserves, but you should consider the testimony of an expert  
13   witness just like you should consider other evidence in the  
14   case, and if you should decide that the opinion of the expert  
15   witness is not based on enough education or enough experience,  
16   or if you should conclude that the reasons that the expert gave  
17   in support of the opinion isn't good or sufficient to support  
18   it, or if you should conclude that the opinions of one expert  
19   is outweighed by all the other evidence or by the opinion or by  
20   other evidence or by the opinion of another expert, then you  
21   can disregard the expert's opinion in whole or in part, because  
22   that's -- you are the judges of the facts, and you can consider  
23   that opinion.

24           Now, also lay people can give opinions, and I believe  
25   it was Mr. Christopherson who this applied to. I may be wrong,

1 but I believe I'm right. He can give an opinion on something  
2 if it's based on his or her personal knowledge and is  
3 rationally based on his or her perception of something.

4 So if you find that an opinion given by a nonexpert  
5 witness is based on personal knowledge and is rationally based  
6 on his perception or her perception of the events, you can  
7 consider, you can give it such weight as you want to give it.  
8 That's up to you.

9 Now, we've had a discussion here up to date of sort  
10 of the general framework and rules that you apply sort of in  
11 doing the job you're going to have to go do. We're now going  
12 to turn to the issues that you have to decide, and I'm going to  
13 give you instructions on those.

14 You have to decide whether ePlus has proved by a  
15 preponderance of the evidence that Lawson has infringed  
16 directly or indirectly claims three, 26, 28, or 29 of the '683  
17 patent, whether Lawson has proved -- Lawson has proved by clear  
18 and convincing evidence that those same claims are invalid  
19 either for anticipation or obviousness, whether ePlus has  
20 proved by a preponderance of the evidence that Lawson has  
21 directly or indirectly infringed claims one, two, six, nine,  
22 21, 22, or 29 of the '516 patent, whether Lawson has proved by  
23 clear and convincing evidence that claims one, two, six, nine,  
24 21, 22, or 29 of that patent are invalid, and whether ePlus has  
25 proved by a preponderance of the evidence that Lawson has

1 directly or indirectly infringed claim one of the '172 patent  
2 and whether Lawson, in turn, has proved by clear and convincing  
3 evidence that that claim is invalid.

4 Now, there are different kinds -- you've got those  
5 claims in your book, and people have referred to them  
6 throughout the trial. There are different kinds of claims at  
7 issue in the case. There are system claims and method claims.  
8 All claims, whether they are system or method, contain elements  
9 or requirements sometimes that people have referred to them as,  
10 or the elements or limitations on the claims.

11 The system claims in this case are claim three of the  
12 '683 patent, claims one, two, six, nine, 21, 22, and 29 of the  
13 '516 patent, and claim one of the '172 patent. And to infringe  
14 a system claim, an accused system has to contain each of the  
15 elements in that particular claim, and you know what the  
16 elements are.

17 They are small little paragraphs that follow the  
18 introductory language, the prefaces that say an electronic  
19 system comprising, or a system, et cetera, or a method, et  
20 cetera, and then it contains specific things that have to be  
21 done to be within the reach, protective reach of the claim, and  
22 if an accused system contains each of those elements, then it  
23 infringes. If it doesn't, then it doesn't.

24 In fact, if it doesn't -- if, say, the claim has six  
25 elements, if you find that it contains five of the elements but

1 doesn't contain the sixth, then it doesn't infringe, so it has  
2 to have them all.

3           There also are method claims, and those, in this  
4 case, are claims 26, 28, and 29 of the '683 patent, and that  
5 method claim recites a series of steps that have to be  
6 performed, and to infringe a method claim, it must be proved  
7 that use of an accused system performs each of the steps as  
8 defined in the claim, and, again, they have to prove all of it.  
9 If they only prove one out of five, then that's not enough. If  
10 they prove five out of six, that's not enough.

11           Now, you've also heard some evidence from the experts  
12 about independent and dependent claims. An independent claim  
13 simply recites its own elements or steps and does not refer to  
14 any other claim. A dependent claim includes all the elements  
15 or steps of another claim, that is the claim from which it  
16 depends, plus one or more other elements or steps.

17           So it will say a system comprising or a method  
18 comprising or method for doing this as recited in claim one  
19 which also, or that also does, and that's a dependent claim  
20 because it recites the claim that it comes from.

21           A dependent claim, of course, is infringed only if  
22 all elements or the steps of the independent claim, as well as  
23 the other element listed in the dependent claim, are shown to  
24 exist in an accused system or method. So in other words, to  
25 prove infringement of the dependent claim, you have to prove,



1 A, that all of the elements of the claim from which it depends  
2 are infringed and the one which is new as well. Now, the  
3 dependent claims at issue in this case are claim 29 of the '683  
4 patent, and claims two, six, and 22 of the '516 patent.

5 These instructions are numbered. If you need to know  
6 that, all of this is recited for you in instruction number 17  
7 so you can identify, but you can also tell by the language they  
8 use as well.

9 And all of the other claims here are independent  
10 claims. The claims here, all of them actually, whether they  
11 are system claims or method claims, use the term comprising.  
12 Comprising simply means including but not limited to or  
13 contain. Thus, claims that contain the word comprising cover  
14 any accused system or method that includes the elements of the  
15 claims even if that accused method or system includes  
16 additional functionality or steps.

17 What is important is whether the accused system or  
18 method of a claim using the term comprising includes all the  
19 elements of the claim. If it does, then infringement is proved  
20 even if the accused system or method includes even more  
21 functionality or features.

22 Now, to decide the issues of infringement and  
23 invalidity, you're going to need to understand the claims of  
24 the patents because as both lawyers, I think, have pointed out  
25 and was in the video before, the claims define the boundaries

1 of the rights that ePlus has in its patents, that anybody has  
2 in their patents.

3 Now, those instructions -- I mean those patents are  
4 in your notebook, and each of the claims that are at issue are  
5 highlighted in yellow, and I've defined the claim terms, and  
6 you have to use those terms, and they are in your notebook as  
7 well, and you use those same definitions in deciding both  
8 infringement and invalidity. And the definitions are those as  
9 would be given and are understood by one of ordinary skill in  
10 the art, and you've heard people talking about.

11 One of the few things that I think the parties agreed  
12 upon in this case is who was the person of ordinary skill in  
13 the art, and that is someone in the field of computer science  
14 with an undergraduate Bachelor of Science degree and some  
15 practical programming experience, perhaps about a year or two,  
16 and having an understanding of the basic principles of supply  
17 chain management and procurement during the 1993 to mid 1994  
18 time frame.

19 If the Court has not given you a definition, then the  
20 words of a claim are to be given their usual and ordinary  
21 meanings. The parts of the patent that precede the claim are  
22 called the abstract, and I believe somebody pointed that out to  
23 you -- that has some evidentiary value, of course, because it  
24 tells you things -- and the written description or  
25 specification, but neither the written description nor the

1 abstract nor the drawings, which are called figures, can be  
2 infringed. The infringement is of the claims, not the things  
3 that precede the claims, and that's what you are looking at.

4 The term published by a vendor was used, and I'll  
5 remind you of that definition. I think they read it, and you  
6 probably have it perfectly in mind now, but published by a  
7 vendor is used in the definition of the claim term  
8 catalog/product catalog.

9 Published simply means to make generally known.  
10 Published by a vendor simply means that at some point in time,  
11 a vendor, such as a supplier, a manufacturer, or a distributor,  
12 has made generally known or has disclosed an organized  
13 collection of items and associated information, preferably but  
14 not necessarily including the part number, price, catalog  
15 number, vendor name, vendor ID, a textual description of the  
16 items, and images of or relating to the item.

17 Now, two of the claims here contain what is referred  
18 to as means for performing a stated function in the elements,  
19 and you've got those interpreted in your book as well. Claim  
20 three of the '683 patent and claim one of the '172 patent have  
21 elements that also include the means plus function  
22 requirements.

23 That term, means for, has a special meaning in patent  
24 law. One example is that claim three of the '683 patent uses  
25 the phrase means for selecting the product catalogs to search.

1 When it uses that term, means to do something, it's called a  
2 means plus a function.

3 Here, the means is recited, and then the function is  
4 to do something. What is the function, to search, in the  
5 example that I just gave you? A means plus function element  
6 covers a structure or a set of structures that perform the  
7 particular function that is outlined, and that is either  
8 identical or equivalent to at least one of the structures  
9 described in the patent for performing that function.

10 The issue of whether two structures are identical or  
11 equivalent is for you to decide. I've identified the  
12 structures described in the patents, and they are in your  
13 juror's notebooks as are the functions.

14 All right, now, let's discuss for a moment how a  
15 claim defines what it covers. You probably have this in mind  
16 pretty well, but I think I better just make it clear. A claim  
17 I said has a preface. That's that beginning thing. You'll  
18 notice that in these claims, at some point before that  
19 highlighting occurs and after all that verbiage occurs and I'm  
20 going to use the '683 patent as an example, you have many, many  
21 pages in there of description in the specification and the  
22 abstract, and then on column 24, right under appendix X, it  
23 says we claim, and it is from that point that the claim, i.e.,  
24 the boundaries of the invention become defined.

25 The first one of these claims that you have to worry

1 about is claim three, and it's highlighted for you, and it's an  
2 electronic sourcing system comprising, and then it has the  
3 elements set forth below it. That's what you are looking at.

4 Each element is then stated in a single sentence, and  
5 if an accused system or method satisfies each of these  
6 requirements, then it's covered by the claim. In other words,  
7 what does covered by the claim mean? It means it infringes the  
8 claim. So if an accused system, and you've got the list of  
9 them, you'll have them right in here in your verdict form, and  
10 you'll remember that Dr. Weaver, when Mr. Robertson was talking  
11 to him and asked him questions, defined which of the five  
12 systems he thought infringed which, each of the claims, and  
13 you'll have that identified in your verdict form for you to  
14 look at.

15 So that means that -- let's just say configuration  
16 one, and I don't know if this is right or not, but if they say  
17 configuration one infringes only claim one of the -- claim  
18 three of the '683 patent, then that's all you have to decide,  
19 but if they say it infringes every one of them, the claims,  
20 then you have to decide that, too, and that's all outlined for  
21 you on your verdict form as well.

22 So let's talk just briefly about infringement  
23 generally. Patent law gives the owner of a valid patent the  
24 right to exclude others from importing, making, using, offering  
25 to sell, or selling the patented invention or product made by a

1 patented method within the United States during the term of the  
2 patent. Any person or business entity that has engaged in any  
3 of those acts, that is importing, making, using, offering to  
4 sell, or selling, et cetera, that I just read, without the  
5 patent owner's permission infringes the patent.

6 The parties here agree that ePlus has not given any  
7 such permission to Lawson. Here, ePlus alleges that Lawson's  
8 accused system and methods directly and indirectly infringe the  
9 yellow highlighted claims in your juror notebook for each the  
10 '683, '516, and '172.

11 The verdict form asks you to determine whether ePlus  
12 has shown by a preponderance of the evidence whether any of  
13 Lawson's accused system or methods infringe, either directly or  
14 indirectly, the asserted claims of those three patents. ePlus  
15 has to prove by a preponderance of the evidence the issue of  
16 infringement. What does that mean?

17 Preponderance of the evidence simply means to prove  
18 that something is more likely so than it is not so, or in other  
19 words, a preponderance of the evidence in the case means such  
20 evidence, as when considered and compared with the opposing  
21 evidence, has a more convincing force for you and produces in  
22 your minds belief that what is sought to be proved is more  
23 likely true than it is not true.

24 I don't mean in singling out numbers here for you to  
25 tell you where that is, but the parties emphasized these

1 burdens so much in our arguments, the lawyers did, if you need  
2 to refresh your memory on what preponderance means for ePlus  
3 and what clear convincing means for invalidity for Lawson, you  
4 can look at 23. That's for infringement. Invalidity is dealt  
5 with in another thing. I'll tell you what that is later.

6 Now, infringement, of course, has to be based, as you  
7 know and you've learned, on a claim-by-claim basis so that  
8 there may be infringement of one claim and not another. That's  
9 something you're going to have to decide.

10 Now, when you are deciding infringement, you must  
11 only compare Lawson's accused systems and methods to the claims  
12 of the ePlus patents. In deciding the issue of infringement,  
13 you may not compare Lawson's accused systems and methods to  
14 ePlus's commercial products and methods. You don't compare  
15 product to product. You do the system that's accused, whether  
16 it's a system or a method, against the claims of the patent.  
17 So whether or not Lawson's products that they sell and ePlus's  
18 products are the same or different is not a matter that you get  
19 into.

20 A patent can be infringed directly or indirectly.  
21 Direct infringement occurs if the accused system or method is  
22 covered by one or more or all of the claims in the patent.  
23 Direct infringement of a method claim results if a single actor  
24 performs all of the steps of that claim.

25 What's indirect infringement? Indirect infringement

1 results if the defendant, here, Lawson, induces another to  
2 infringe a patent or contributes to the infringement of a  
3 patent by another person. I'm going to explain those two types  
4 of infringement now.

5           Lawson would be liable for directly infringing  
6 ePlus's patents if you find that ePlus has proven by a  
7 preponderance of the evidence that Lawson itself has made,  
8 used, offered to sell, sold, or imported into the United States  
9 the invention defined in any claim of the patents. Then that  
10 claim has been infringed if they proved that by a preponderance  
11 of the evidence.

12           Now, remember that someone can directly infringe a  
13 patent without knowing that what they are doing is an  
14 infringement of the patent. You don't have to know you are  
15 infringing the patent to infringe it. You either do or you  
16 don't. So you can directly infringe a patent even though you  
17 believe in good faith that what you are doing is not an  
18 infringement of the patent.

19           The issue is does it or doesn't it, not what state of  
20 mind the direct infringer had. In every infringement analysis,  
21 the language of the claims as well as the nature of the accused  
22 system or method dictates whether infringement has occurred.  
23 To infringe a claim that recites capability and not actual  
24 operation, an accused system or method need only be capable of  
25 operating in the described mode. Thus, depending on the



1 claims, an accused system or method may be found to infringe if  
2 it is reasonably capable of satisfying the claim elements or  
3 limitations even though the system or method may also be  
4 capable of non-infringing modes of operation. The fact that a  
5 product or process may operate in a manner that does not  
6 infringe is not a defense to a claim of infringement against  
7 Lawson if its system is also reasonably capable of operating in  
8 a manner that satisfies the claim elements.

9 Now, Lawson -- I mean ePlus also alleges that Lawson  
10 has actively induced other people to infringe the  
11 patents-in-suit. In particular, who are they alleged to have  
12 induced? The Lawson customers in this case. That's what it's  
13 about.

14 To show induced infringement, ePlus has to prove by a  
15 preponderance of the evidence that someone, here, Lawson's  
16 customers, have directly infringed the ePlus patents, and that  
17 Lawson -- so they have to show that the customers directly  
18 infringe. And remember, it doesn't make any difference whether  
19 the customers knew or didn't know that they were infringing,  
20 because if you infringe, you infringe whether you know it or  
21 not. But they also, ePlus has to prove by a preponderance of  
22 the evidence that Lawson has actively and knowingly aided and  
23 abetted that direct infringement.

24 So here, in order to find that Lawson has induced  
25 somebody else to infringe, you do have to consider Lawson's

1 state of mind, i.e., that they actively and knowingly aided and  
2 abetted the indirect infringement by their customers. ePlus,  
3 thus, must show that Lawson actually intended to cause the acts  
4 that constitute infringement and that Lawson knew of the patent  
5 and that Lawson knew or should have known that its actions  
6 would lead to actual infringement.

7 Knowledge of the patent may be established by a  
8 finding that Lawson had actual knowledge of the patent or that  
9 Lawson deliberately disregarded a known risk that ePlus had a  
10 protective patent. Intent to cause the acts that constitute  
11 direct infringement may be demonstrated by evidence of active  
12 steps taken to encourage direct infringement such as  
13 advertising an infringing use or instructing someone on how to  
14 engage in the infringing use.

15 It is not necessary to show that Lawson has directly  
16 infringed as long as you find that someone, here the Lawson  
17 customers, directly infringed and that Lawson did the things  
18 that I said constituted inducement. If there's no direct  
19 infringement by anyone, there can be no induced infringement,  
20 and, of course, induced infringement must also be assessed on a  
21 claim-by-claim basis.

22 Now, just to review that, what you're going to have  
23 to do here is look and see if Lawson's systems, all or any of  
24 them, actually infringed the patent when they were used by the  
25 customers of Lawson. Then you have to decide whether Lawson

1 actively and knowingly helped -- that's called aiding and  
2 abetting -- the direct infringement, and there was evidence  
3 that you have to decide about who was involved in talking to  
4 the customers, what they told the customers. You consider all  
5 of that as well, but remember that in order to prove by -- I  
6 mean to prove induced infringement, ePlus has to show that  
7 Lawson actually intended to cause the acts -- and I'm reviewing  
8 this little part of the instructions -- that constitute  
9 infringement, that Lawson knew of the patent and that Lawson  
10 knew or should have known that its actions would lead to actual  
11 infringement. Pay attention to the rest of that instruction as  
12 well, but I wanted to recapitulate for you that.

13 Now, there's another kind of indirect infringement  
14 that's involved, and that's called contributory infringement.  
15 ePlus also argues that Lawson is liable for this contributory  
16 infringement by contributing to the direct infringement of  
17 ePlus by third parties, again, the Lawson customers.

18 As with direct infringement, you have to determine  
19 contributory infringement on a claim-by-claim basis. Lawson is  
20 liable for contributory infringement of a claim if ePlus proves  
21 by a preponderance of the evidence, one, that Lawson sells,  
22 offers to sell, or imports within the United States a  
23 component of a Lawson system or apparatus for use in a process  
24 during the time the patent is in force.

25 I don't think there's any issue here, is there, about

1 the time frame? If there were infringing sales, is there an  
2 issue about the patent being enforced? I don't remember any  
3 evidence about it, and I'm trying to take it out of the case.  
4 Mr. Robertson, Mr. McDonald, was there any evidence adduced to  
5 that point?

6 MR. McDONALD: I don't think that's an issue, Your  
7 Honor.

8 THE COURT: No, I don't think it's an issue here,  
9 either. Do you?

10 MR. ROBERTSON: No, sir.

11 THE COURT: While I told you about that during the  
12 time the patent is enforced, there's no issue as to that. You  
13 still have to be comfortable with that. Two, that the  
14 component or apparatus has no substantial non-infringing use;  
15 three, that the component or apparatus constitutes a material  
16 part of the invention of the ePlus patent; and four, that  
17 Lawson is aware of the ePlus patent and knows that the system  
18 for which the component or apparatus has no other substantial  
19 use may be covered by a claim of the ePlus patent, and that the  
20 use of this apparatus or component directly infringes the claim  
21 by -- and that direct infringement here would, of course, be  
22 the person who they are alleged to be contributing to infringe  
23 the patent, and that would be the Lawson customers. That is  
24 the use by Lawson customers directly infringes the claim.

25 It is not necessary to show that Lawson has directly

1 infringed as long as you find that someone, here, the  
2 customers, has directly infringed, but if there's no direct  
3 infringement by anybody, then there can be no contributory  
4 infringement, and, of course, this has to be assessed on a  
5 claim-by-claim basis as well.

6 And now we'll turn to these means-plus-function  
7 claims in claim three of the '683 and claim one of the '172  
8 patent, and those definitions are set out for you on the second  
9 through fourth pages of your juror notebook glossary of claim  
10 terms.

11 A product or a process meets a means-plus-function  
12 requirement of a claim. Again, look at the claim language and  
13 look at it element by element. So it meets -- a process or  
14 product meets a means-plus-function element of a claim if, one,  
15 it has a structure that is the product or process -- here, has  
16 a structure or a set of structures that perform the identical  
17 function that is recited in the claim, and, two, the structure  
18 or set of structures is either identical or equivalent to one  
19 or more of the described sets of structures that I've given for  
20 you and performing the functions that are recited.

21 If the product does not perform the specific function  
22 recited in the claim, then the means-plus-function requirement  
23 is not met, and the product does not literally infringe the  
24 claim.

25 Alternatively, even if the product has a structure or

1 set of structures that perform the functions recited in the  
2 claim, but the structure or set of structures that performs the  
3 function is either not identical or not equivalent to one or  
4 more of the structures or sets of structures that I have  
5 defined for you, then the product does not literally infringe  
6 the asserted claim.

7 A structure or a set of structures may be found to be  
8 equivalent to one of the sets of structures I have found, and  
9 that's -- if you'll look at your notebook and look at your  
10 terms, you will see that there is -- for each one of these  
11 means-plus-function things, it says, means for building  
12 requisition that uses data from said database relating to  
13 selected matching items on set order list. Boy, that's a  
14 mouthful, isn't it?

15 There's a function described, and then there's a  
16 corresponding structure. Now, we're talking about -- now, what  
17 does it take for some structure to be equivalent to what I have  
18 defined? Well, it's equivalent if a person, having ordinary  
19 skill in the art or in the field, would have considered the  
20 differences between what I have described and what actually  
21 happens to be insubstantial at the time the patent issued if  
22 that person would have found the structures performed the  
23 function in substantially the same way to accomplish  
24 substantially the same result.

25 In deciding whether the differences would be

1 insubstantial, you may consider whether a person having  
2 ordinary skill -- ordinary level of skill in the field of  
3 technology of the patents would have known of the  
4 interchangeability of the two structures or sets of structures.

5 Interchangeability itself is not enough in order for  
6 the structures to be considered interchangeable. The  
7 interchangeability of the structures must have been known to  
8 persons of ordinary skill in the art at the time the patent  
9 issued. That's August of 1994.

10 The fact that a structure or set of structures is  
11 known now and is equivalent is not enough. The structure or  
12 set of structures must also have been available at the time the  
13 patent issued.

14 All right, we're through now talking about  
15 infringement. We're going to move to the invalidity defense,  
16 but you've been sitting here for awhile. Would you like to  
17 take a little rest before we go there? We'll take about a 15-,  
18 20-minute break and then come back and do invalidity.

19  
20 (Jury out.)  
21

22 THE COURT: Will you tell me who testified to  
23 interchangeability and equivalency for purposes of contributory  
24 infringement? As I was going through that -- I'm not sure we  
25 had evidence. If you did, it went right by me. Who did it?

1 MR. ROBERTSON: It's for the means-plus-function  
2 claims, Your Honor.

3 THE COURT: Yes, I know that.

4 MR. ROBERTSON: Dr. Weaver was talking about the  
5 various programs that perform that functionality during his  
6 testimony. I mean, I think that's -- quite frankly, the  
7 structures disclosed in your construction show that there are  
8 various types of programs that can actually perform that  
9 functionality.

10 THE COURT: But what he didn't say was he didn't  
11 address interchangeability or equivalency on that point.

12 MR. ROBERTSON: It's not a doctrine of equivalents  
13 concept, Your Honor.

14 THE COURT: I understand that, but it still uses the  
15 word and the term. I think it is one of the dumbest concepts  
16 of patent law, to tell you the truth, and I think that you have  
17 to have an expert actually come in and say what it is so a jury  
18 can understand it, and I'm not sure we have it in this case.

19 It is a very difficult concept for any juror to grasp  
20 without the aid of expert testimony, and I don't think we ever  
21 did it. Why didn't -- you must have thought he did it, because  
22 you didn't get up and say anything or object to the  
23 instruction, so you must think I'm one of the dumbest --

24 MR. McDONALD: It was part of our JMOL when we were  
25 saying go claim by claim and element by element doing the



1 necessary analysis --

2 THE COURT: Well, no. You said he didn't go claim by  
3 claim and he didn't do it the right way. You didn't get into  
4 the fact that he didn't offer the opinion on structural  
5 interchangeability.

6 MR. McDONALD: What we said was he gave only  
7 conclusory opinions and failed to do the analysis necessary,  
8 and that is exactly the sort of analysis --

9 THE COURT: I know you made those statements, but you  
10 didn't put it out in terms of contributory infringement.

11 MR. McDONALD: Or this is actually the means plus  
12 function clauses, but it was certainly meant to encompass  
13 those.

14 Just to be clear, our motion for JMOL did include  
15 those means-plus-function elements, and specifically that Dr.  
16 Weaver's conclusory --

17 THE COURT: I don't mean contributory infringement.  
18 I mean means plus function.

19 MR. ROBERTSON: I think Dr. Weaver testified when we  
20 went through all those manuals exactly what the programs were  
21 that were performing that functionality.

22 Remember, these are computer programs, so we went  
23 through the purchase order manual, we went through the  
24 inventory control manual. He was testifying based on that.  
25 Quite frankly, I think he was saying that the claims were

1 literally satisfied based on the Court's construction.

2 THE COURT: I know that's what -- I agree he did  
3 that. The question is, having done that and having no evidence  
4 on the issue of any interchangeability, why is that a good  
5 instruction?

6 MR. ROBERTSON: As I'm standing here right now, I  
7 don't specifically recall whether or not he said there can be  
8 programs outside this that are disclosed, that are not  
9 disclosed in this purchase order manual, but I don't think he  
10 did it with respect to every single one, but I don't have  
11 memory respect to every single. He certainly did do it with  
12 respect to the Court's construction.

13 THE COURT: I know that. I know he did that. He  
14 said specifically this does this function, this is the  
15 structure that does this function.

16 All right. Well, it's done now. We'll take a  
17 recess.

18  
19 (Recess taken.)

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